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Nick (Nicholas Sheppard) Bromer
402 Stackstown Road
Marietta, PA 17547-9311

EXAMINER

KLEBE, GERALD B

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3618

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GROUP 3600

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 23

Application Number: 09/995,097
Filing Date: November 27, 2001
Appellant(s): BROMER, NICK (NICHOLAS SHEPPARD)

Nick (Nicholas Sheppard) Bromer
For Appellant

EXAMINER'S ANSWER

This is in response to the Appeal Brief filed 3/31/2003 and the Supplemental Appeal Brief filed 9/24/2003.

(1) *Real Party in Interest*

The brief does not contain a statement identifying the Real Party in Interest. Therefore, it is presumed that the party named in the caption of the brief is the Real Party in Interest, i.e., the owner at the time the brief was filed. The Board, however, may exercise its discretion to require an explicit statement as to the Real Party in Interest.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is considered by the examiner as providing additional disclosure and some of which is not fully consistent with the disclosure as originally filed because of the following:

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a. Relative to Appellant's discussion of the recitation of claim 2: "For a user having a toe and standing on a skate, a skate braking mechanism comprising: a brake;" further stating that "the user's toe is recited in the preamble because the toe's upward motion ("dorsiflexion" is the medical term for it) is the basis of the Appellant's invention."

The examiner considers, to the contrary, that the specification at page 12, lines 5-23 infuses further meaning to the word "dorsiflexion" when applied to the claims, stating in part that "dorsiflexion" can mean (see lines 22-23): "any upward motion of the front of the foot (forward of the ankles)"; and also states that (see lines 17-21): "A downward motion of the phalanges relative to the metatarsals that helped to arch the foot and raise the metatarsals would be "dorsiflexion" within the meaning of the claims, if the resulting motion of a brake actuator were upward."

Therefore, in the examiner's understanding of this disclosure for purposes of interpretation of the claims, the specification enables the word "dorsiflexion" whether the movement of the toe(s) in actuating the brake is upward or curved downward relative to the metatarsals provided "the resulting motion of a brake actuator were upward". Thus, the specification is enabling the word "dorsiflexion" for understanding the claims as any use of the foot to operate a brake actuator by any of: (i) upward movement of the toe(s) including upward motion of the metatarsals of the foot, (ii) upward movement of the toe(s) relative to the metatarsals, and (iii) downward movement of the toe(s) that helps arch the foot and raise the metatarsals, so long as the movement results in upward motion of the brake actuator.

b. Relative to Appellant's further discussion pointing to structures disclosed in the non-elected species shown in Figure 3 (see Supplemental Appeal Brief, page 2, lines 4-13):

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(i) since this discussion refers to structures shown in the non-elected species (Fig 3) the examiner considers these comments to be irrelevant to the issues under appeal and not contributory to the understanding of the issues and claims under appeal, which address the structures of the elected species shown in Fig 1 and which are disclosed in those portions of the specification that deal with enabling the elected species shown in Fig 1;

(ii) furthermore, the examiner notes that a number of the structures of the non-elected species (shown in Fig 3) that are brought into the discussion by the Appellant at page 2, lines 4-13 of the Supplemental Appeal Brief are not found as similar structures of the elected species or not found in the specification sufficient to enable one skilled in the relevant art to make and use the invention of the elected species. Specifically, the elected species (Fig 1) does not have a double-ended rod, both ends of which are attached to the toe lifter and attached at the brake shoe to pull up the lever arm about the hinge pin 130, as discussed by Appellant in the brief, and therefore this part of the Appellant's discussion is irrelevant material for understanding the invention of the elected species.

c. Relative to Appellant's discussion at page 3, lines 8-13 in the Supplemental Appeal Brief, the Appellant provides additional disclosure in attempting to overcome the specification's failure to mention the significance and structural importance of the shading lines on the second arm extension 120 of the brake of the elected species. The examiner considers the discussion to be additional disclosure of significant matter not found in the specification as filed.

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Added disclosure by Appellant's brief is not relevant to the issues under appeal related specifically to the rejection under 35 USC 112, 1st Paragraph based on the disclosure as filed.

d. Further, in Appellant's explanation and expanded discussion of the meaning of the shaded lines shown on arm 120 in Fig 1, Appellant cites the specification passage at page 8, line 19 of the specification, but adds additional explanation that "The widening is needed for the following reason: the arm is of course wide enough at the toe cap 110 to accommodate the toes, but it cannot be as wide as the toes at the level of the brake shoe 15, or else the arm 100 would scrape the ground while turning a corner ...". This, also, is tantamount to added disclosure relating to best mode, not found in the specification as filed, and therefore which should not be considered in the appeal.

e. In addressing dependent claim 3 Appellant states (page 4, lines 7-8): "Dependent claim 3 recites that the lifter is pivoted to be moved upward by the toe. This is discussed above; pin 130 is the pivot." [examiner's emphasis]. The examiner takes the position that, in recitations as broadly stated as those of claims 2 and 3, (claim 3 depending from the independent claim 2), as recited in the claims there is no requirement that the pivot be at the axle of one of the wheels of the skate, such as "pin 130".

f. In addressing independent claim 8, Applicant states that "It recites that the brake shoe is pivoted to rotate about an axle of another wheel."

The examiner would point out that, in recitations as broadly stated as those of claim 8, the recitation "wherein the brake shoe is pivoted to rotate about an axle of another wheel...", would not require an interpretation that the pivot point of the arm to which the brake shoe is attached be

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located at an axle of another wheel, but merely that, in pivoting, the brake shoe would be caused to undergo rotational motion relative to such axle. (Refer to the specification page 7, line 23 to page 8, line 2.)

g. In addressing claim 9, Applicant states that the subject matter wherein the brake shoe comprises fiber reinforced elastomer is shown in Fig 3; however, the examiner points out that Figure 3 does not identify the material of the brake shoe. On the other hand, the examiner agrees that the limitation is supported in the specification at page 10, line 4.

h. In addressing claim 10, Applicant introduces non-relevant material, since claim 10, being drawn to a non-elected species has been withdrawn from further consideration and therefore is not a matter under appeal.

i. Addressing the limitations of claim 11, the examiner agrees that the subject matter is supported at page 10, line 15 of the specification.

j. Addressing the limitation of Claim 12 which recites "a return spring" structure, the examiner points out that this limitation is supported in the specification at page 8, lines 16-18, but is not shown in the Figure 1 of the elected species, as is required. Refer to the Office action mailed 4/01/02 (Paper No. 4), paragraph 5.b.

k. Appellant does not address the subject matter of claim 13, wherein it is recited, in part, "...the lifter is positioned above the toe...".

l. In addressing the limitations of claim 14 wherein it is recited in part that "...the lifter is pivoted to be moved upward by the toe", the examiner questions the sufficiency of the original disclosure with respect to this issue, presumably disclosed in the specification at page 7, line 4 to page 8, line 2, specifically, since it has not been disclosed what the structural configuration is

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that enables the toe to engage the lifter with the (toe portion of the) boot B being an intervening structure, as shown in Fig 1, where the lifter 110 is clearly not a boot structure, and where, clearly, the boot toe cap portion is indicated to be under the lifter.

m. Applicant states that "Claim 16 is similar to claim 1...". The examiner notes that claim 1 having been cancelled is not at issue in the appeal. On the other hand, to the Appellant's point, the examiner finds claim 16 to be a substantially broadly recited claim and consequently, it has been given more than one rejection because its limitations are anticipated by more than one prior art reference of record.

n. The examiner agrees that the subject matter of claim 17 is mentioned in the specification at page 7, line 25, but questions the enablement, since (i) neither the recitation of the claim, nor the disclosure including the drawings discloses a supporting frame for the wheels, and consequently, (ii) it appears from the rendition of figure 1, that the structure of the single pivoted arm 100 is a planar structure, and the accompanying disclosure at page 7, line 25 to page 8, line 10, says nothing to dispel that conception. Therefore the examiner posits that the disclosure lacks enablement because the brake shoe carried on the planar arm 100 hinged at the end of the axle of another wheel would not be expected to be able to move to engage a wheel without structural interference with not only adjacent wheels of the skate but also the conventional in-line wheel skate frame, such as found in the prior art made of record.

(6) Issues

The Appellant's statement of the issues in the brief is substantially correct. The changes are as follows:

- With regard to Appellant's statement of issues (i): no change; the examiner agrees.

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- With regard to Appellant's statement of issues (ii): In the absence of Appellant's clear accedence in writing to the rejection of claim 16 in the outstanding Office action mailed 07/02/2003 (Paper No. 18) under 35 USC 102(b) as being anticipated by Intengan (US 6053511), the examiner posits that this statement of issues should read as: Whether claims 2, 3, 12, and 16 are anticipated by Intengan (US 6053511).

(7) Grouping of Claims

Appellant's brief includes a statement that claims 2 and 16 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

6,053,511	INTENGAN	4-2000
5,232,231	CARLSMITH	8-1993
5,183,275	HOSKIN	2-1993

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

- a. Claims 2-3, 5-6, 8-9, and 11-17 are rejected under 35 U.S.C. Sec. 112, First Paragraph. This rejection is set forth in prior Office Action, Paper No. 18, and is repeated herein for ease of reference by the Board.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to

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which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 2-3, 5-6, 8-9, and 11-17 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Independent claim 2 recites limitations of a skate braking mechanism wherein a lifter is connected to a brake and is pressable upward by the toe of the user to actuate the brake; independent claim 8 recites limitations of a skate brake and a brake shoe coupled to the lifter and wherein the brake shoe is pivoted to rotate about an axle of another wheel to bear on at least one wheel of the skate brake when actuated; and independent claim 16 recites limitations of a skate braking mechanism comprising a brake and means for actuating the brake by pressing upward the toe of the user.

These recitations are not enabled by the disclosure, including the drawings, since it appears that there would be mechanical interference among the structures of the brake mechanism and the wheel frame of the skate as disclosed that would prevent the pivotal motion of the braking structure, and to enable the brake shoe to fit between the adjacent wheels of a conventional in-line skate in order to engage the wheel to be braked.

Appropriate correction or clarification is required. No new matter may be entered.

b. Claims 2, 3, 12, and 16 are rejected under 35 U.S.C. Sec. 102(b). This rejection is set forth in prior Office Action, Paper No. 18, and is repeated herein for ease of reference by the Board.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 2, 3, 12, and 16, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Intengan (US 6053511).

Intengan discloses, for a user having a toe and standing on a skate, a skate braking mechanism comprising: **(re: claims 2 and 16)** a brake (55) and a lifter (combination of 42, 46, 47, 48, 49 54, 56) connected to the brake and pressable upward by the toe of the user to actuate the brake (refer to Fig 3A), whereby the brake is actuated according to a natural motion of the user to maintain balance (refer col 2, lines 31-37); and further **(re: claim 3)** wherein the lifter is pivoted (about the pivots 54 and 47-48) to be moved upward by the toe; and further **(re: claim 12)** comprising a return spring (53) counteracting an upward pressing motion of the toe.

Claim 16, as best understood, is rejected under 35 U.S.C. 102(b) as being anticipated by Carlsmith (US 5232231).

Carlsmith discloses (Fig 2) a skate braking mechanism for a user having a toe and standing on a skate, wherein the braking mechanism comprises a brake (the ground engaging device shown depending from the rear of the skate) and means for actuating the brake by pressing upward the toe of the user (as shown in Fig 2, the user presses upward the toes of the foot in the skate to be braked, thereby elevating the front of the skate upwardly and thereby bringing the brake into contact with the ground).

c. Claim 8 is rejected under 35 U.S.C. Sec. 103(a). This rejection is set forth in prior Office Action, Paper No. 18, and is repeated herein for ease of reference by the Board.

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 8, as best understood, is rejected under 35 U.S.C. 103(a) as being unpatentable over Intengan (US 6053511) in view of Hoskin (US 5183275).

- a. Intengan discloses, for a user having a toe and standing on a skate having at least one wheel, a skate brake actuated by dorsiflexion as broadly claimed, comprising: a lifter moved upward by the dorsiflexion to actuate the brake; and comprising a brake shoe coupled to the lifter.
- b. When actuated, Intengan's brake shoe bears upon the ground supporting surface of the skate rather than on the at least one wheel of the skate.
- c. However, Hoskin teaches a ground engaging brake shoe for an in-line roller skate that includes a movable roller for selective engagement with a wheel of the skate when the brake shoe is actuated to bear upon the ground.
- d. Therefor, it would have been obvious to one of ordinary skill in the art at the time the instant invention was made to have modified the brake shoe of Intengan to include a roller pad arrangement to bear upon the wheel of the skate in accordance with the teachings of Hoskin in order to further distribute the braking forces of the brake pad over an enlarged surface area to reduce the wear rate of the brake shoe as suggested by the reference at column 2, line 64 to column 3, line 3.

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e. Regarding the further limitation of the claim wherein the brake shoe is pivoted to rotate about an axle of another wheel, the combination of Intengan and Hoskin as discussed above pivots the lifter of the brake shoe about a transverse axis mounted on the skate's wheel frame. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have relocated the pivot axis of the lifter to be an axle of another wheel of the skate, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

(11) Response to Argument

a. Response to Appellant's argument relative to rejection of claims 2-3, 5-6, 8-9, and 11-17 under 35 USC 112, 1st Paragraph.

Appellant argues that the examiner neglects relevant portions of the specification, citing features that are shown and disclosed for the embodiment of the non-elected species Fig 3, that could be used by one of skill in the art to conceptualize and build Appellant's elected embodiment of the skate brake species of Fig 1; and that the examiner does not identify those parts of the Appellant's device that would interfere with its operation; and that the examiner underestimated the level of skill in the art; and that the examiner has not carefully read the specification; that the rejection is self-contradictory; and that the examiner guesses and makes assumptions.

The examiner replies that the disclosure must be enabling at least for the elected species of Fig 1 and contends that it is not so enabling since there would be structural interference between the brake mechanism as disclosed and the conventional in-line skate frame or "truck".

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That neither the disclosure as filed, including the drawings, nor the recitations of the claims addresses any particular features of the frame supporting the wheels, nor is it recited in the claim(s) that there is a frame to support the in-line wheels. Therefore, there is no alternative but for the examiner to assume that the Appellant considers the wheel-supporting frame feature of the in-line skate to be known; that is, to be a conventional in-line skate frame similar, for example, to the frames (“trucks”) shown in the prior art of record in the case. With a conventional frame supporting the wheels of the skate in-line, the instant application, as filed, does not disclose how the brake structure of the elected species shown in Fig 1 would be able to function to brake a wheel. By virtue of the added disclosure by Appellant in this instant brief, it is clear that the brake arms must be appropriately bent (in ways to be discovered by the manufacturers’ engineers) in order to fit and function. The structure 100 in Figure 1 appears to be a planar structure pivoted on the axis 130 of the frame whose pivoting actuation would result in structural interference with the frame of a conventional in-line skate to an extent not immediately assessable by the examiner given the lack of details provided in the disclosure.

The newly disclosed information provided by the Appellant in the instant Supplemental Appeal Brief notwithstanding, with so many significant structural limitations being left to the concern of the skilled artisan, the examiner, having carefully read the specification as evidenced by these comments, is forced to conclude that the disclosure, as filed, is non-enabling.

b. Response to Appellant’s argument relative to rejection of claims 2-3, and 12 under 35 USC 102(b) as being anticipated by Intengan (US 6,053,511).

(i) Appellant argues that Intengan teaches against elevating the toes to brake.

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The examiner answers that Intengan meets the recitations of the claim and that the toe motion to actuate Intengan's brake is within the meaning of the toe motion of Appellant's own disclosure (refer to the specification at page 12, lines 17-21, where it is stated "A downward motion of the phalanges relative to the metatarsals, that helped to arch the foot and raise the metatarsals, would be "dorsiflexion" within the meaning to the following claims if the resulting motion of a brake actuator were upward."

(ii) Appellant argues that Intengan teaches against using the force of the toes to brake, citing several passages of text in the reference that relate to the anatomy and kinetics of the foot and force amplification considered at the time of Intengan's disclosure.

The examiner answers that Intengan meets the recitations of the claim. Appellant fails to provide structural differences to distinguish over the prior art of Intengan.

(iii) Appellant argues that the examiner removes a limitation from the claim by adopting a strained interpretation that Intengan's lifter structure is activated by being "pressed upward by the toe" as recited in the claim, arguing the upward pressing with the toes cannot possibly actuate Intengan's brake.

The examiner answers that the toe motion to activate Intengan's brake lifter indeed involves the motion "pressing upward by the toe" and is effective in actuating the brake as understood when comparing the height of the toe as shown in Intengan Fig 2A versus the height of the toe as shown in Fig 3A , since it is clear that the toe has moved upward and this is accomplished by a pressing motion of the toe itself. Moreover, the toe movement shown to activate the lifter of Intengan is within the meaning of Appellant's own disclosure (refer specification at page 12, lines 17-21, where it is stated: "A downward motion of the phalanges

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relative to the metatarsals, that helped to arch the foot and raise the metatarsals, would be “dorsiflexion” within the meaning to the following claims if the resulting motion of a brake actuator were upward.”, and further states at lines 13-14: “ ... the invention includes a lifter farther back than the toes...”.

c. Response to Appellant’s argument relative to rejection of claim 16 under 35 USC 102(b) as being anticipated by Carlsmith (US 5,232,231).

Appellant argues that the Examiner adopts a strained interpretation that Carlsmith (Fig 2) shows the feature recited in claim 16 of braking “means for actuating the brake by pressing upward the toe of the user” because Carlsmith shows braking by changing the angle of the entire foot relative to the ground rather than by the action of “pressing upward the toe of the user” as recited.

The Examiner answers:

(i) The Carlsmith reference Figure 2 clearly meets the limitations of the claim as broadly recited;

(ii) The Appellant’s argument relies on implied features not recited in the claim when he states that the claimed action of “pressing upward the toe of the user” would not actuate the Carlsmith brake unless the rest of the foot were also pressed upward, since the claim recitation does not preclude the action shown by Carlsmith’s Fig 2 which does involve pressing upward the toe of the user;

(iii) The Figure 2 of Carlsmith, interpreted broadly as required, does clearly involve the action of “pressing upward the toe of the user” and this results in the brake being actuated; and

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(iv) By the disclosure of the instant application at page 12, lines 9-11, the Appellant teaches that the instant "invention contemplates brake activation by any lifting action of the front portion of the foot".

12) *Regarding Appellant's attachment "Table of Authorities and Explanantion of Relevance"*

Acknowledgment of Appellant's Model, demonstrated at the on-site interview of May 15, 2002 of record in the case by the Interview Summary entered as Paper No. 5 (Official signed copy given to Applicant at the end of the interview).

Appellant's Affidavit of September 23, 2002 is of record in the case, entered as Paper No. 10.

The examiner acknowledges both the demonstration of the model at the on-site interview of May 15, 2002 and Applicant's affidavit attesting that the model was built prior to November 27, 2001.

The examiner's position on the model is that it has structural features that differ from the features of the invention disclosed in the application as originally filed and therefore is not relevant for consideration of the issues on appeal in the case.

For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,

MBZ
Gbklebe/Examiner AU 3618
December 29, 2003

BRIAN L. JOHNSON
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600

Conferees:

Brian L. Johnson/SPE AU 3618 *BLJ*

Frank B. Vanaman/Primary Examiner AU 3618 *FBV*

Lesley D. Morris/SPE AU 3611 *LD*

Nick (Nicholas Sheppard) Bromer
402 Stackstown Road
Marietta, PA 17547-9311